

REMARKS

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- | | |
|------------|---|
| Group I. | Claim 1, drawn to a retroviral particle that is pseudotyped with VSV G protein. |
| Group II. | Claims 2-8, drawn to a tumor specific retroviral expression vector. |
| Group III. | Claim 9, drawn to a plasmid. |
| Group IV | Claims 10-12, drawn to a replication defective retroviral expression vector. |
| Group V | Claim 13, drawn to a method of treating a tumor. |
| Group VI | Claim 14, drawn to a method of detecting a genetically modified cell. |
| Group VII | Claim 15, drawn to a method of making a retroviral particle. |
| Group VIII | Claim 16, drawn to a method of making a retroviral particle. |
| Group IX | Claim 17, drawn to a cell line. |

Responsive to the Requirement for restriction, Applicants elect to prosecute the invention of Group V, Claim 13, with traverse, drawn to a method of treating a tumor. To the extent that Groups II to IX are separately grouped, Applicant traverses the Restriction Requirement and requests that these eight groups be combined with Group V elected herein.

Applicant reserves the right to file a continuing application or take such other appropriate action as deemed necessary to protect the non-elected inventions. Applicant does not hereby

abandon or waive any rights in the non-elected inventions.

Accordingly, applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Traversal of Restriction of Groups II to IX

Criteria for Restriction

The necessary criteria for a proper restriction requirement have been clearly defined. Applicant refers to Section 1850 of the Manual of Patent Examining Procedure (MPEP), entitled "Unity of Invention Before the International Searching Authority". Under the Requirement for "Unity of Invention" it states that:

" ... when the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims

In applying PCT Rule 13.2 to international applications ... to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2."

Applicant respectfully refers to the Written Opinion and the International Preliminary Examination Report issued during the prosecution of the corresponding international patent application (PCT/CA00/00445) from which the present application is a National Phase Entry.

There, the International Preliminary Examining Authority (IPEA) has previously examined the claims of the application and determined that the claims should be grouped into only two (2) groups. In both of these documents the IPEA stated that the technical feature (Rule 13.2 PCT) common to these groups is tumor specific gene expression through retroviral delivery. Thus, the claims of Groups II to IX (claims 2-17 as stated by the IPEA) meet the requirements of PCT Rule 13.2 and the Examiner should therefore permit retention of claims 2-17 in the application, as clearly determined by the IPEA, and not impose an additional separation of the claims.

In addition, the Examiner refers to PCT Rule 13, stating that "... PCT Rule 13 does not provide for multiple products within a single application". Applicant wishes to note, however, that PCT Rule 13 does not exclude multiple products within a single application. It is thus implicit that what is not excluded should therefore be included.

Further, the Examiner has only stated that no special technical feature exists for Group I as defined by PCT Rule 13.2 because claim 1 allegedly does not define a contribution over the prior art. The Examiner has failed to show how a special technical feature is not found in the claims of the Examiner's Groups II to IX.

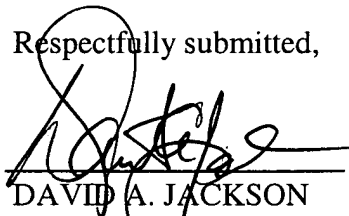
To the extent that Groups II to IX are separately grouped, Applicant respectfully traverses these restrictions and requests that they be combined as indicated above.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and

an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



DAVID A. JACKSON
Attorney for Applicant(s)
Registration No. 26,742

KLAUBER & JACKSON
411 Hackensack Avenue
Hackensack, New Jersey 07601
(201) 487-5800
Date: February 23, 2004